

Reconsideration of the application is respectfully requested in view of the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Applicants thank the Examiner for withdrawing the rejections under 35 U.S.C. § 103(a) in view of Peeters *et al.* (U.S. Patent No. 5,741,787) and Scholz *et al.* (U.S. Patent No. 5,446,036).

Applicants would also like to express their gratitude to the Examiner for taking the time to conduct the telephone interview on January 21, 2003.

Applicants believe no new matter is present in this or any other portion of the present amendment.

I. Provisional Obviousness-Type Double Patenting Rejection

Upon the notification of allowable subject matter, Applicants will submit a terminal disclaimer under 37 CFR § 1.321(c) to overcome the provisional obviousness-type double patenting rejection in view of copending U.S. Patent Application No. 09/526,855.

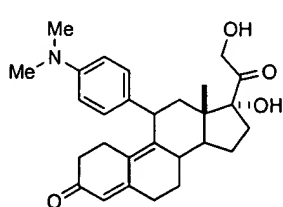
II. The Instant Invention is non-Obvious in view of Torelli *et al.*

The Examiner has maintained the rejection of the instant claims under 35 U.S.C. § 103(a) in view of Torelli *et al.* (U.S. Patent No. 4,634,695). In view of declaration by Dr. H.K. Kim ("the Kim Declaration"), Applicants respectfully traverse the rejection.

Applicants can rebut a *prima facie* case of obviousness by presenting comparative test data showing that the claimed invention possesses unexpectedly improved properties or properties that the prior art does not possess. *In re Dillon*, 16 U.S.P.Q. 1897, 1901 (Fed. Cir. 1990). Applicants maintain that a *prima facie* case of obviousness has not been established by the Examiner. However, the comparative data filed with the Kim declaration rebuts any *prima facie* case of obviousness.

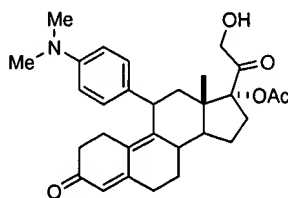
As the Kim Declaration shows, the compounds of Torelli *et al.* do not exhibit significant antiprogestational activity, as demonstrated by compound 9. In fact, compound 9

exhibited absolutely no antiprogestational activity. In sharp contrast, the compounds of the present invention, as represented by compound 41, exhibit strong anti-progestational activity over the same dose range, increasing from ~20% inhibition to ~55% inhibition. Clearly, as attested to by Dr. Kim, this is a surprising and unexpected result.



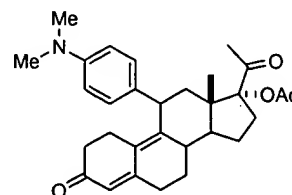
9

Torelli *et al.* No
antiprogestational
activity.



41

Inventive compound.
Strong antiprogestational
activity.



69B

U.S. Patent Application
No. 09/526,855. Strong
antiprogestational
activity.

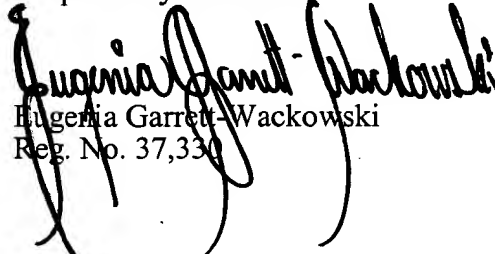
In view of the data provided in the Kim Declaration, Applicants submit that the compounds of the present invention display properties that the compounds of Torelli *et al.* do not. These properties represent objective evidence that is more than sufficient to rebut a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the 35 U.S.C. § 103(a) rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,


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